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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,834	12/08/2000	Neil A. Willcocks	2280.2680	1867
5514 7590 10/12/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/731,834

Applicant(s)

WILLCOCKS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-27, 29, 30 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-27, 29, 30 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 8/6/2007.
2. Claims 1-10, 12-27, 29-30 and 36-40

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 12-27, 29-30, 32 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (6,336,099 hereinafter Barnett).

With respect to claims 1-4, 6-11, 14-19, 21, 23-27, 29-30, 32, 36, 37, 38, 39 Barnett teaches a method for motivating a consumer to promptly purchase a product and/or service electronically over a computer network (Figure 1). Providing from a server over the computer network to a consumer's computer a program that causes said computer to

(a) display an offer for sale of a product and/or service that may be purchased immediately by said consumer via the computer network (Figure 1);

(c) when said consumer makes an electronic purchase of said of said product and/or service by electronically accepting said offer, provide to said server an indication of acceptance and a current displayed value of said incentive (Figure 1, 4);

registering at the server an initial time at which said incentive is initially displayed (i.e. the demographic data file 42 contains data representative of the demographic

inquiries presented to the user at the time that the user requests a download of coupon data from the coupon package data file 40, as well as data representative of the users' response thereto);

registering at said server an acceptance time at which said consumer electronically accepts said offer (i.e. the demographic data file 42 contains data representative of the demographic inquiries presented to the user at the time that the user requests a download of coupon data from the coupon package data file 40, as well as data representative of the users' response thereto); and

comparing said initial time and said acceptance time to verify the provided current displayed value of said incentive (i.e. the time when the coupon is presented to the user and the time when the coupon is printed is compared if a long time has passed. Eg. A month , then the coupon value is decreased to 0)(col. 11, lines 66 to col. 12, lines 1-8); providing said consumer the current value of said incentive, if the current value of said incentive is verified (i.e. if the time hasn't expired then the consumer is presented with the current value of the offer) (col. 11, lines 66 to col. 12, lines 1-8) the incentive presented via a web page (Figure 8); wherein said incentive is electronically redeemed for said verified current displayed value (i.e. the coupon is redeemed electronically for the current value)(Figure 1).

With respect to (b) concurrently display an incentive for purchasing said product and/or service promptly, wherein the program causes said incentive to be initially set to a first non-zero an initial value and then changes said incentive over a period of time to at least one other value. Barnett teaches the incentive starts with a value and if not

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redeemed within a predetermined period of time, the coupons will be deleted from the database and therefore the value will be zero (col. 12, lines 11, lines 66 to col. 12, lines 1-8). With respect to concurrently displaying the offer with the incentive to purchase said product and/or service. Since, Barnett, teaches on col. 13, lines 24-26 teaches "The availability of the coupon could be **time-sensitive**, which would provide **further incentive to the user to use the system in a prompt and efficient manner**" then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have made the offer and the incentive to purchase the product to be concurrently displayed in order to provide a reminder to the customer to promptly redeem the offer.

With respect to the newly added feature of the offers being displayed at the web site of the vendor from which the product or service may be purchased. In Barnett claim 12 further teaches ... "the central system presents to the remote user via the remote terminal one or more links to web sites associated with the offers and claim 13 depends from claim 12 and it recites ... "wherein the web site is associated with the retailer providing the one or more incentive offers". As can be seen by claims 12-13 of Barnett, in certain embodiments of Barnett, the user has direct communication with retailer 10 by the user clicking on the retailer's web site. The user is provided with the incentive offers directly from the retailer's web site, which provides the one or more incentive offers. In addition claims 26-27, Barnett further teaches linking **the customer to the retailer which provides the one or more offers**. Barnett doesn't just teach redeeming the offer through the retailer but also the retailer having a web site in which

the retailer provides **one or more offers...**to the remote user.

With respect to figure 12, Barnett further teaches wherein a consumer who frequently uses said incentive for purchasing products and/or services is accorded a more favorable incentive than a consumer who frequently uses said incentive to purchase goods and/or services (col. 12, lines 48-54).

With respect to claim 13, Barnett further teaches wherein said frequent consumer is accorded a higher maximum incentive value (col. 13, lines 30-42).

With respect to claim 20, Barnett further teaches wherein said information relates to a location of said consumer (see claims 5 and 31 Of Barnett).

Claim 5 further recites that the incentive is presented via a web banner. Official notice is taken that it is old and well known to present advertisements or the like on web banners. A web banner or banner ad is a form of advertising on the World Wide Web. This form of online advertising entails embedding an advertisement into a web page. It is intended to attract traffic to a website by linking them to the web site of the advertiser. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included presenting the incentive via a web banner in order to obtain the above mentioned advantage.

Response to Arguments

5. Applicant argues that Barnett doesn't teach a direct communication channel between the user and a vendor. The Examiner respectfully disagrees with Applicant because In Barnet claim 12 further teaches "...the central system presents to the remote user via the remote terminal one or more links to web sites associated with the offers and claim 13 depends from claim 12 and it recites ...“wherein the web site is associated with the retailer providing the one or more incentive offers”. As can be seen by claims 12-13 of Barnett, in certain embodiments of Barnett, the user has direct communication with retailer 10 by the user clicking on the retailer's web site. The user is provided with the incentive offers directly from the retailer's web site, which provides the one or more incentive offers. In addition claims 26-27, Barnet further teaches linking **the customer to the retailer which provides the one or more offers**. Barnett doesn't just teach redeeming the offer through the retailer but also the retailer having a web site in which the retailer provides **one or more offers...**to the remote user.

6. Applicant argues that Barnett doesn't teach direct purchase from the vendor of the product and/or service displayed. The Examiner disagrees with Applicant because as stated above the use can link to the vendor web site in order to be presented with offers and in order to redeem the offers electronically.

7. Applicant argues that Barnett doesn't teach an incentive that progressively decreases in value over time, to at least one other than a non-zero value. The Examiner disagrees with Applicant because Barnett further teaches on col. 12, lines “**the coupon management program can vary redemption value of any coupon already**

downloaded to user's computer" that hasn't been redeemed by "**update redemption amounts for coupons whose issuers have decided to change the discount amount"** The whole idea of Barnett is to motivate the customer to make a prompt purchase by incentivizing the customer to redeem the offers in a timely manner.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Applicant argues that Barnett doesn't teach registering an acceptance time in a server and using the registered times to verify a value of an incentive. The Examiner wants to point out that in Barnett, the coupons are time-sensitive and the system further keep tracks of when the coupon is first downloaded and requested (data link 4) and the acceptance time is when the customer redeems the coupons (Figures 1 and 9). If the coupon is requested (registered) and not redeem (acceptance) within a certain time period then the issuer might decide to change the discount amount in order to "**provide further incentive to the user to use the system in a prompt and efficient manner"** (col. 13, lines 24-26). Barnett as a whole teaches the claimed invention.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

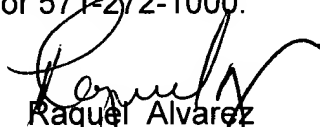
Point of contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
10/1/2007